

U.S. Patent Application No. 10/020,861

REMARKS

Claims 1-6, 9, 10, and 12-24 are pending. By this Amendment, no claims are canceled, amended, or added.

In view of the reasons stated below, reconsideration and withdrawal of the rejections are respectfully requested.

37 C.F.R. § 1.178

In paragraph 1, the Office Action stated that the original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. Applicant will provide either the original patent or a statement as to its loss or inaccessibility upon receipt of a notice of allowance.

35 U.S.C. § 251

Claims 5, 6, 9, 10, and 24 are rejected in paragraph 2 of the Office Action under 35 U.S.C. § 251 as improper capture of broadened claimed subject matter, the rejection specifically stating that "a broadening aspect is present in the reissue, which was not present in the application for patent." Specifically, the rejection asserted:

1) The non-final Office Action (Paper Number 13) rejected claims under 35 USC §102 (b) in view of US 3,421,471 to Richter that claimed container door's "spaced walls" did not patentable define from the perpendicularly-arranged walls of the reference's container door and otherwise indicating claim limitations being anticipated by the prior art. In response, independent claim 9 was amended to include terminology of "and parallel" to further define the container door's walls'

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arrangement: "a container door fitted in said container and comprising two walls, spaced apart from and parallel to each other". The rejection further asserted that applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patently define from the prior art: see page 4 of Applicant's response (Paper Number 15) filed June 25, 1999.

2) The claim was additionally amended at that time to specifically require that the claimed means for locking and unlocking the claimed container door was located between two "parallel" walls: "means for locking and unlocking said container door comprising locking elements provided within said container door between said two parallel walls and being displaceable into a moved-in position and into a moved-out end position and, when moving out, penetrates into said recesses within the container walls". The rejection asserted Applicants' arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patently define from the prior art: see page 4 of Applicant's response (Paper Number 15) filed June 25, 1999.

3) The claim was additionally amended at that time to specifically require specific structural arrangement of claimed locking elements, plates, rotatable disk and motor: "every locking element being in the form of a projection from a plate which is directed parallel to the outwardly directed wall of said container door, wherein all plates share a common drive in the form of a rotatable disk driven by a motor and acting in the locking and unlocking direction for connecting rods provided for displacing the plates, the plates being fixed in the moved-in end position and in the moved-out end position by said connecting rods". The rejection states that Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patently define

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from the prior art: see pages 4-5 of Applicant's response (Paper Number 15) filed June 25, 1999

4) The claim was additionally amended at that time to specifically require other structural features of the "means for providing a curved path" including particulars of that claimed element including its arrangement as regards each of the plurality of plate structures and couplers: "said means for providing for providing a curved path further comprising structure to maintain and move every [locking element] plate parallel to an outwardly directed wall of said to parallel walls of the container door [and includes] by means of couplers, said couplers for every plate being [connected thereto which are] parallel to each other and [which are] rotatably [supported at the locking element] connected to said plate and also to said outwardly directed wall so that, as a result of the couplers, there is a predetermined distance between [the locking element] every plate and said outwardly directed wall in the moved-in state, which distance decreases during the outward movement until the locking element comes into contact with a contact surface in the recess against which the locking element is pressed in its moved-out end position". The rejection asserted Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art: see page 5 of Applicant's response (Paper Number 15) filed June 25, 1999.

5) Page 6 of Applicant's arguments filed with that amendment (Paper Number 15) of June 25, 1999, indicates that Applicant also relies on the above amendments and to each of the specific arguments to overcome the other prior art rejections including rejection over 35 USC §103 in view of Richter '471 and additionally Richter '471 in view of US Patent 1,929,341 to Wegner. As applied

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against the 35 USC §102 rejections and again against the 35 USC §103 rejections, the arguments relating allowability to each amendment are specifically stated in Applicant's Remarks.

The rejection concluded "inasmuch as the above-indicated limitations are a result of amendment specifically directed at overcoming prior art rejections, as indicated at Applicant's arguments relating the subject matter of the amendments to the allowability of the invention, that subject matter has been surrendered.

In the section entitled Response to Arguments, the rejection stated that Applicant had provided a diagram as part of the arguments but had not provided any evidence to indicate that the present claims are more specific than the scope of the rejected claims as indicated by the outer circle in that diagram whereby those arguments are not persuasive.

The diagram and an explanatory excerpt from Ex parte Eggert are again presented in footnote 1.¹ In the issue at point, the scope of rejected claim 1, as

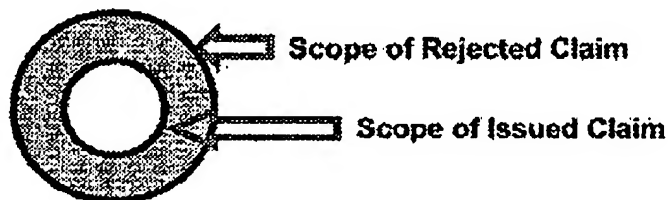
¹ See Ex parte Eggert, 67 USPQ2d 1716, 1717 (Bd. Pat. App. & Inter 2003) ("The changing scope of a claim during the administrative examination process as it is amended to overcome prior art rejections can be viewed as a series of concentric circles. As illustrated in Drawing 1 [see below], the scope of rejected claim 1 (once amended) is the outer circle and the scope of amended issued claim 1 (twice amended) is the inner circle. The shaded area between the circles represents subject matter which is only narrower than the scope of the rejected claim but only broader than the scope of the issued claim. In our view, the surrendered subject matter is the outer circle of Drawing 1 because it is the subject matter appellants conceded was unpatentable. The subject matter of the shaded area was not subject to the administrative examination process as the examiner was never directly presented with a claim which fell within the scope of the shaded area. Thus, appellants have never conceded that a claim falling within the scope of the shaded area of Drawing 1 is unpatentable and therefore, in our view, such subject matter is not barred by the recapture rule." (emphasis added).

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addressed in Paper Number 15 of the prosecution file history of U.S. Patent 6,000,732, is represented by the outer circle and the scope of the allowed claim is represented by the inner circle. The claim amendments in Paper Number 15 represented the final time the claims were amended prior to allowance. This is the situation addressed in Ex parte Eggert as well. Hence, the shaded area between the inner and outer circles represents subject matter narrower in scope than the claim before the rejection in Paper Number 8 and broader in scope than the allowed claims. As stated in the footnote,

[T]he surrendered subject matter is the outer circle ... because it is the subject matter ... conceded [as] unpatentable. The subject matter of the shaded area was not subject to the administrative examination process as the examiner was never directly presented with a claim which fell within the scope of the shaded area. Thus, appellants have never conceded that a claim falling within the scope of the shaded area ... is unpatentable and therefore ... such subject matter is not barred by the recapture rule.

Therefore, the scope of claim 1, before being amended in Paper Number 15, is represented by the outer circle. The scope of claim 1, after being amended in Paper Number 15, is represented by the inner circle. All subject matter present in



Drawing 1


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claim 1 before being amended is represented by the outer circle and is subject to the Recapture Doctrine and is conceded by Applicants as unpatentable under the rule stated in Eggert. However, the limitations recited above as being subject to recapture were amended into claim 1 in Paper 15. These limitations, combined with the limitations present in claim 1 before being amended, are represented by the inner circle. Therefore, Applicants respectfully submit that the above-recited limitations are not subject to the recapture rule because they were not conceded as necessary to patentability by the rule stated in Eggert and the Examiner has never considered the patentability of a claim with a scope intermediate between claim 1 before being amended in Paper Number 15 and claim 1 after being amended in Paper Number 15. For reasons stated in the Amendment filed 1 September 2004, Applicants further submit that the claims are patentable over the cited prior art.

Conclusion

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested and the Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,


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